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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,603	10/23/2001	Stephen H. Decatur	94.0046	8192

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EXAMINER

BROOKS, MATTHEW L

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/004,603	<b>Applicant(s)</b> DECATUR, STEPHEN H.	
	<b>Examiner</b> Matthew L. Brooks	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: for example in Claim 1; after step (f) wherein an interest owner determines *if* will pursue the prospect; a determination to pursue step must be made before step (g) that of providing any compensation.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-10** are rejected under 35 U.S.C. 102(e) as being taught and anticipated by Pub. No.: US 2002/0188500 A1 (Kwok et al); Provisional Applications 60/243713 and 60/243712 filed by KWOK which fully support the PG Pub are attached herein.
5. With respect to **Claim 4** (which is used for purpose of demonstration, because Examiner determines the claim to be most comprehensive): Kwok discloses

A method for developing prospects to recover valuable components on identified property of an interest owner which comprises (see Title):

- a. Making available to potential prospecting participants through a computer-based network a first set of property information for the identified property and interest owner conditions under which a potential prospecting participant will submit a proposal for prospecting the property including a compensation schedule for the participant which has at least two options for compensation selectable by the participant and content requirements for the proposal for prospecting ([0026] and [0042]);
- b. Receiving by the interest owner through a computer based network from a potential prospecting participant, who has agreed to said interest owner conditions, a proposal for prospecting the property ([0033] and [0043]);
- c. Evaluating the proposal for prospecting submitted to the interest owner to determine if it is acceptable to the interest owner ([0033] and [0043]);
- d. Awarding rights to prospect the property to such potential prospecting participant if the proposal for prospecting is acceptable to the interest owner ([0033] and [0043]);
- e. Allowing the participant given the award to access through a computer-based network an additional set of property information comprising a detailed property database residing on a computer network controlled by the interest owner to allow such participant to interpret data from the database and prepare an interpretation report identifying at least one specific prospect on the property potentially containing valuable

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components ([0033] and [0043], all report preparation can be found in [0072] through [0074]);

f. Submitting the interpretation report to the interest owner for evaluation to determine if the interest owner will pursue the prospect ([0033] and [0043] and [0027] and [0028]);

g. If the interest owner declines to pursue the prospect, awarding such participant a limited time opportunity to obtain other interested parties to pursue such prospect with the interest owner ([0033] and [0043]); and

h. Providing any compensation required to the participant during any stage of the above according to the compensation schedule (inherent within Kwok).

6. With respect to **Claims 2 and 5**: Kwok discloses

wherein said valuable components comprise gas or oil or combination thereof, said database includes seismic data and the interest owner will pursue the prospect by undertaking a well completion to the prospect ([0005] and [0006]).

7. With respect to **Claims 3,6,8 and 10**: Kwok discloses

wherein the participant accessing the detailed property database has agreed to interest owner conditions of restricted use and disclosure of detailed property database ([0013] through [0016] certainly if the information is "proprietary")

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kwok.

Claims 1-10 are rejected in the alternative under 35 U.S.C. 103 as being unpatentable

over the Kwok reference. Kwok discloses all of the informational features normally provided in a prospecting for a component and purchase of real estate transaction.

Kwok arguably does not discuss directly the use of a confidentiality agreement or preparation of a report. In determining the obviousness of applying what is generally known in the prospecting industry to what is known in the world of the Internet one must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976)). The internet, to one of ordinary skill in the art for sometime now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be for one computer to access and download files from another computer located at a different site than the first. Also, the prospecting industry has utilized confidentiality agreements and prepared property data reports for years to evaluate conditions on a property, risks associated with prospecting and confidentiality

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agreement is known as a method of keeping of said data "proprietary". Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the Internet to access the data in a separate data base, to have a user sign a confidentiality agreement to review the data, and then said user to prepare a report to evaluate the risks associated with prospecting property. The desirability to do this is clearly to keep data on property confidential so a user may recap testing costs and yet also allow a future buyer to evaluate data and prepare a report to present to future partners.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patent No.: 6,658,460; which teaches enough to be sufficient for a 102/103 rejection

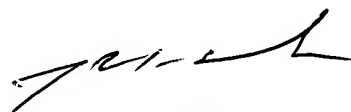
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLB  
6/26/2006



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